

REMARKS

The Examiner has restricted the instant application to a patentable distinct species of the claimed inventions groups by the Examiner as:

- I. Claims 1-37, 49, 50, 53, and 54 drawn to a printer and method of printing that includes providing printing instructions, generating a pattern at the printer using the pattern information independent from the printer instructions and printing a document that comprises both a pattern and content, classified in class 358, subclass 3.28
- II. Claims 38-48, 51 and 52, drawn to a photocopies with an optical scanner for scanning a document, an image processor for performing a processing step on the output signals produced by the scanner and a printer responsive to the modified image signals for printing a modified image, classified in class 358, subclass 505.

Moreover the Examiner contends that the inventions are distinct from each other.

It is respectfully noted that 35 U.S.C. 121, the law, states in relevant part: "If two or more ***independent AND distinct*** inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions." Emphasis added. Note that 37 C.F.R. §§ 1.141 and 1.142 also speak of "independent and distinct" inventions. ***The Examiner has only argued that the inventions are distinct.***

The Examiner has not also argued, as required by 35 U.S.C. 121, that the inventions are also independent. Therefore, the restriction requirement is improper and Applicants request that it be withdrawn.

Note that Applicants do not consider the explanation of the meaning of "independent" and "distinct" in MPEP §802.01 persuasive. The MPEP §802.01 Meaning of "Independent" and "Distinct":

"35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. In 37 CFR 1.141, the statement is made that two or more "independent and distinct inventions" may not be claimed in one application.

This raises the question of the subjects as between which the Commissioner may require restriction. This, in turn, depends on the construction of the expression "independent and distinct" inventions.

"Independent", of course, means not dependent. If "distinct" means the same thing, then its use in the statute and in the rule is redundant. If "distinct" means something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that 35 U.S.C. 121: "enacts as law existing practice with respect to division, at the same time introducing a number of changes."

The report on the hearings does not mention as a change that is introduced, the subjects between which the Commissioner may properly require division.

The term "independent" as already pointed out, means not dependent. A large number of subjects between which, prior to the 1952 Act, division had been proper, are dependent subjects, such as, for example, combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section 121 of the 1952 Act were intended to direct the Commissioner never to approve division between dependent inventions, the word "independent" would clearly have been used alone. If the Commissioner has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above. Such was clearly not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term "distinct" with the term "independent", indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact, "distinct" inventions, even though dependent.

INDEPENDENT

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process.

DISTINCT

The term "distinct" means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use, or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term related is used as an alternative for dependent in referring to subjects other than independent subjects.

It is further noted that the terms "independent" and "distinct" are used in decisions with varying meanings. All decisions should be read carefully to determine the meaning intended."

The arguments presented in the MPEP appear to rest on two pillars:

- 1) Apparently, the novel statutory construction theory being put forward is that in the absence of legislative history on a given point, the law doesn't mean what the law says. Applicant submits that the statutory construction as described by the Supreme Court should be given deference: "[I]n interpreting a statute a court should always turn to one cardinal canon before all others. . . . [C]ourts must presume that a legislature says in a statute what it means and means in a statute what it says there." ¹ Certainly, "[w]hen the words of a statute are unambiguous, then, this first canon is also the last: 'judicial inquiry is complete.'" *Id.*
- 2) "Independent and distinct" has the same meaning as "distinct." This is a logical impossibility if "independent" and "distinct" have different definitions, and clearly MPEP §802.01 concedes that that they do have different definitions and helpfully provides them.

With respect, Applicants suggest that the Examiner has not satisfied 35 U.S.C 121 in the restriction requirement; therefore, the requirement should be withdrawn. If the Examiner wishes to maintain the restriction requirement, the Applicants respectfully request that the Examiner also explain how the subject matter represents two "independent" inventions, according to the definition of "independent" given in MPEP §802.01.

Indeed, the Examiner notes that the inventions of Group I and Group II are related as subcombinations disclosed as usable together in a single combination, suggesting that while there may be elements that are "distinct" they are not necessarily also "independent." As the inventions may be used in a single combination, it is unclear how the searching of the two groups would impose a serious burden upon the Examiner, when as there is relation, it would appear that search results of one group would be potentially applicable to the group – thereby suggesting an improvement in efficiency in keeping the disclosed embodiments together.

Moreover, the restriction requirement is improper as the Examiner has only argued that the inventions presented in Group I and Group II are Distinct – offering no reason or justification for a finding that they are also independent. Despite these arguments, among others not specifically laid out herein, Applicant is requested to elect a species.

Applicant thus provisionally elects, with traverse, Group I, claims 1-37, 49, 50, 53, and 54, and provisionally cancels the claims of Group 1, claims 38-48, 51 and 52.

¹ Connecticut Nat'l Bank v. Germain, 112 S. Ct. 1146, 1149 (1992).

Applicant has fully responded to Examiner's concerns as outlined in Requirements for Reconsideration of June 19, 2007. If Groups I and II are indeed held to be distinct inventions, Applicant may file continuing applications pursuing noted claims 38-48, 51 and 52 (Group II).

It is believed that all of the pending Claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending Claims (or other Claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any Claim, except as specifically stated in this paper, and the amendment of any Claim does not necessarily signify concession of unpatentability of the Claim prior to its amendment.

Applicant believes that no fees are currently due; however, should any fee be deemed necessary in connection with this Amendment and Response, the Commissioner is authorized to charge deposit account 08-2025, referencing the Attorney docket number 200207150-1.

Respectfully submitted,

By: _____



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